

### **Remarks**

Claims 1-6, 8-27, 29-38, and 42-51 are now pending. Reconsideration of the instant application in light of the following remarks is respectfully requested.

#### **I. ELECTION/RESTRICTION**

The Examiner withdrew claims 53-55 from consideration as being directed to a non-elected invention. Applicants respectfully disagree with the Examiner's reasons for restricting claims 53-55 and assert such claims should be allowed herein. Nevertheless, applicants hereby reserve the right to pursue such claims in a continuation or other related application and will cancel such claims from the instant application upon an indication of allowance of the remaining pending claims.

#### **II. THE CLAIMED INVENTION IS PATENTABLE OVER THE EXAMINER'S ASSERTED COMBINATION OF PATENTS**

The Examiner rejected claims 1-6, 8-27, 29-38, and 42-50 under 25 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,551,607 to Minerath, III et al. ("Minerath")<sup>1</sup> in light of U.S. Pat. No. 5,436,007 to Hartung et al. ("Hartung"). Applicants respectfully submit that the Examiner's suggested combination of patents fails to render the claimed invention unpatentable and particularly note that neither Minerath nor Hartung provides the requisite motivation or likelihood of success to specifically combine a clay with peptizing agent of the claimed invention to produce a composition having the superior enzyme inhibition activity discovered by applicants to be associated therewith, as discussed in further detail below.

Minerath is directed to a method of sequestering skin irritants using a composition comprising a substrate containing skin irritant sequestering agents which may, in certain embodiments, comprise modified and non-modified clays. While Minerath teaches that the compositions therein may optionally comprise any of a wide variety of extremely broad classes of other compounds (such as buffering agents, viscosity enhancers, fragrances, dyes, etc.), as

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<sup>1</sup> Applicants do not necessarily agree that this patent is properly cited as prior art and hereby reserve the right to swear behind such document hereafter.

acknowledged by the Examiner, there is no specific teaching in Minerath of any composition comprising both a clay and a peptizing agent of the claimed invention.

Furthermore, Minerath provides no suggestion or motivation to specifically select, from among the virtually limitless possible compositions encompassed by combining the various broad additives of Minerath, a peptizing agent of the claimed invention to combine with a clay to achieve a method or composition of the claimed invention. Minerath provides no teaching, suggestion, or direction to one of skill in the art to select any of the various classes of additives listed therein over other classes nor provides any motivation to select any particular compounds from within the various broad classes of additives over other compounds within the classes. Rather, Minerath, in essence, suggests that any of the various classes of additives, and additives within one or more of the broad classes of additives, are of relatively equal suitability for use in the Minerath compositions. Accordingly, one of skill in the art would not be motivated by the broad teachings of Minerath to specifically incorporate a peptizing agent of the claimed invention therein to achieve a composition or method as now claimed.

Furthermore, Hartung fails to provide the requisite motivation missing from Minerath to specifically select, and combine with clay, any of the peptizing agents of the claimed invention to achieve any composition or method as now claimed. While Hartung is directed to skin compositions that can be delivered to the skin via a wipe or diaper to treat diaper rash and may optionally comprise EDTA as a viscosity enhancer, Hartung nevertheless fails to teach or suggest *any* composition comprising a clay, let alone a composition specifically comprising a clay and a particular peptizing agent, as required by the claimed invention. Nor does Hartung suggest that any viscosity enhancer, such as EDTA, is suitable for use with clay-containing compositions. Accordingly, it appears the Examiner is citing Hartung merely for its teaching that EDTA is known to be used generally in skin care compositions and not for any teaching or suggestion to specifically combine EDTA in a clay composition (such as those in Minerath).

In light of the above, the Examiner's assertion that one of skill in the art would specifically add EDTA into a composition of Minerath to achieve the claimed invention merely because EDTA is taught to be useful in skin care compositions (in this case by Hartung) is improper. In essence, without any specific motivation in Minerath or Hartung to combine clay

with EDTA, the Examiner's rejection amounts to an argument that it would be "obvious to try" any of the vast and various particular additives encompassed by the description in Minerath, and otherwise known to be useful in skin care compositions, to optimize and achieve a composition of the present invention. While such a rejection is never proper, it is particularly untenable here, where the teachings of Minerath are so broad as to require an extreme undue burden on one of skill in the art to try virtually innumerable possible additives to achieve the claimed invention.

Moreover, the Examiner's cited patents not only fail to teach or suggest any compositions comprising both clay and a peptizing agent of the present invention, but also fail to recognize, teach, or suggest the superior enzyme inhibiting properties that tend to be associated therewith. Applicants have discovered that the cosmetic compositions of the present invention, specifically comprising a combination of clay and at least one of a particular group of peptizing agents, exhibit superior enzyme inhibition in the presence of urine, as compared to other clay-containing cosmetic compositions. For example, as illustrated in Table C and further described on pages 25 and 26 of the instant application, applicants have discovered that compositions of the claimed invention tend to be as much as about 1.4 to 2 or more times as effective in reducing enzyme activity in the presence of urine, as compared to other clay-containing compositions, including one or more compositions which fall within the broad teachings of Minerath.

Therefore, although Minerath broadly teaches a variety of clay-containing compositions that can be produced by combining clay with any of a variety of additives, there is no teaching or suggestion therein (or in Hartung) that compositions comprising both clay and a peptizing agent of the claimed invention would exhibit greater efficacy than any other compositions comprising clay and other additives, or methods, disclosed or encompassed broadly by Minerath.

Accordingly, applicants respectfully submit that the instantly claimed compositions and methods are patentable over the cited patents. The Examiner's rejection should be withdrawn and the claims allowed.

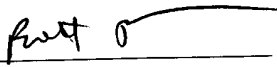
### **III. ALLOWABLE SUBJECT MATTER**

The Examiner has allowed claim 51. Applicants thank the Examiner for this allowance.

#### IV. CONCLUSION

In light of the above, applicant respectfully submits the application is in condition for allowance and requests an early notice of allowance for this application. Should the Examiner have any questions regarding this submission, please contact the undersigned.

Respectfully submitted,

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